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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,146	10/24/2005	Kazuya Sakata	1034232-000040	3252
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EXAMINER				
LE, HOA VAN				
ART UNIT		PAPER NUMBER		
1795				
NOTIFICATION DATE		DELIVERY MODE		
01/09/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/554,146

Applicant(s)

SAKATA ET AL.

Examiner

Hoa V. Le

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 12/08/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

This is in response to Papers filed on 12/22/08.

I. The language "...obtained by...50%" or "mixing...(L)" in a material claim (resin mixture composition), is a product-by-process. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-I], see *In re Thorpe*, 777F.2d 695, 698,227 USPQ 964,966). However, for a patentability of a product-by-process embodiment, it is allowed by law to request and require applicant to provide a convincing evidence on and for the record that the product being made by the claimed processing steps as broadly claimed are always provide an unusual or unexpected results over each of all possible resin compositions using all possible combinations of the teachings and/or suggestions in the applied reference and/or with a skilled artisan at the time the invention was made. An allowed claim or patent would have no value when

someone reasonably shows that at least one of the broadly claimed embodiments does not provide an unusual or unexpected result over one of the applied toner composition. Evidence being not considered during the prosecution must be firstly considered and taken to a full and complete satisfaction before allowing or permitting any other issue to be taken.

II. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwa et al (2002/0076637). For the newly amended embodiment filed on 11/24/08, Mizoo et al (2002/0072006) is further applied.

Iwa et al disclose, teach and/or suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 50,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100, 000 and a gel part of up to 50%. Polymer resin C is made from resins (L) and (H). The tested ratios of resins (L)/ (H) are 97-93/3-7. However, a wider range of a ratio of

resins (L)/(H) can be expected and/or possible to one having ordinary skill in the art at the time the invention was made. At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraphs 0016 to 0024, 0029 to 0051, 0054, Examples. (*) The language "...obtained by...50%" and "mixing...(L)" is a product-by-process. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-I], see *In re Thorpe*, 777F.2d 695, 698,227 USPQ 964,966). Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the resin product "(C)" are always made (@1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on and for the record and (2)

the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (@@) the mixing processing steps from “mixing...(L)” would always provided an unusual or unexpected results over each of all possible combinations of the applied resin compositions using all possible combinations of the teachings and/or suggestions in the applied reference and/or with a skilled artisan at the time the invention was made. An allowed claim or patent would have no value when someone reasonably shows that at least one of the broadly claimed embodiments does not provide an unusual or unexpected result over one of the applied toner composition. Evidence being not considered during the prosecution must be firstly considered and taken to a full and complete satisfaction before allowing or permitting any other issue to be taken. (**) The language “a gel portion...50%”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (L)...50,000...per 1 kg...”, “...vinyl polymer (D)...50,000...per 1 kg...”, “crosslinking agent (A)...equivalent/100 g” or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material

on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely.

For the newly amended embodiment filed on 11/24/08, Iwa et al disclose, teach and/or suggest an addition of one or more binder resins for a desired advantage of obtaining a widely fixing- or (fusing-) range temperature of a toner composition in the art but do not specify a molecular and/or an amount. However, it is known in the art at the time the invention was made to use one or more binder resins with specifications of molecular weight(s) and amount(s). Evidence can be seen in Mizoo et al on at least paragraphs 0167, 0203, 0221, 0393, Table 1 with "a", "c" to "j", claim 27.

Since the above references are all related to binder resin compositions for use in electrographic toner compositions, it would have been obvious to one a having ordinary skill in the art at the time the invention was made to cite one or more binder resins for a reasonable expectation of obtaining a wide range of a fixing or fusing temperature of a toner composition in the photographic art.

III. Applicant's arguments filed on 11/24/08 have been fully considered but they are not persuasive.

The arguments filed on 11/24/08 has been carefully considered but has little values since the above rejection are applied with a new set of the references.

IV. Applicant's arguments filed on 12/22/08 have been fully considered and are found to be convincing. The new amendment is considered and searched.

V. The English language translation of Japanese Patent No. 61-163347 filed on 11/24/08 has been considered. It has about the same teachings and/or suggestions as those applied in the above rejection with respect to the applied primary reference of Iwa et al. Accordingly, it is cumulative for now but may later applied.

VI. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujikawa et al (2002/0098431). For the newly amended embodiment filed on 11/24/08, Mizoo et al (2002/0072006) is further applied.

Fujikawa et al disclose, teach and suggest a binder resin for a toner comprising a vinyl resin (L) having a molecular weight of up to 40,000 and a crosslink vinyl resin (H) comprising a glycidyl crosslinking agent (A) for making a crosslinking copolymer units of styrene and acrylic having a molecular weight of up to 100,000 and having from 0.1% by weight of insoluble matter. The tested ratios of vinyl resins (L)/(H) are about 80/20. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Polymer resin C is made from resins (L) and (H). At least one additional resin D is also disclosed, taught and suggested to be incorporated in the toner. The tested ratios of vinyl resins (C)/(D) are about 90-95/10-5. However, a wider range of the ratio of the vinyl resins can be expected and/or possible to be used one having ordinary skill in the art. Please see the whole disclosure of the applied reference, especially at least on paragraph 0063 to 0065, 0135 to 0140, 0156 to 0161, 0179 to 0181, Examples. (*) The language "...obtained by...50%" and "mixing...(L)" is a product-by-process. According to the MPEP, "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from

a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." (MPEP 2113 [R-I], see In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966). Normally, the product-by-process has its value on product by itself, per se, until applicants convincingly show or provide evidence on an for the record for the patentability of the processing steps of making the resin product "(C)" are always made (@1) a distinct product for each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on and for the record and (2) the distinct product-by-process is always provided an unusual or unexpected results over each of all possible applied crosslinking vinyl resins type (A) of Iwa et al on the record and (@@) the mixing processing steps from "mixing...(L)" would always provided an unusual or unexpected results over each of all possible combinations of the applied resin compositions using all possible combinations of the teachings and/or suggestions in the applied reference and/or with a skilled artisan at the time the invention was made. An allowed claim or patent would have no value when someone reasonably shows that at least one of the broadly claimed embodiments does not provide an unusual or unexpected result over one of the applied toner composition. Evidence being not considered during the prosecution must be firstly considered and taken to a full and complete satisfaction before allowing or permitting any other issue to be

taken. (**) The language “a gel portion...50%”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (H)...1,000,000...per 1 kg...”, “...vinyl polymer (L)...50,000...per 1 kg...”, “...vinyl polymer (D)...50,000...per 1 kg...”, “crosslinking agent (A)...equivalent/100 g” or the like is a property or a measurement of a property of a material. For a patentability of a property of a measurement of a property of a material, it is allowed by law to request and require applicants to convincingly show or provide a distinct property or measurement of a property of the material on the record since (#) an allowed or patented claim would have no value when someone is reasonably shown to the same of obviously about the same property of measurement of the applied material using all possible combinations of the teachings and/or suggestions in the applied Iwa et al (##) arguments alone are not a factual evidence. A showing should be submitted in the next response to this application in order for it to be considered timely.

For the newly amended embodiment filed on 11/24/08, Iwa et al disclose, teach and/or suggest an addition of one or more binder resins for a desired advantage of obtaining a widely fixing- or (fusing-) range temperature of a toner composition in the art but do not specify a molecular and/or an amount. However, it is known in the art at the time the invention was made to use one or more binder resins with specifications of molecular weight(s) and amount(s). Evidence can be

seen in Mizoo et al on at least paragraphs 0167, 0203, 0221, 0393, Table 1 with "a", "c" to "j", claim 27.

Since the above references are all related to binder resin compositions for use in electrographic toner compositions, it would have been obvious to one a having ordinary skill in the art at the time the invention was made to cite one or more binder resins for a reasonable expectation of obtaining a wide range of a fixing or fusing temperature of a toner composition in the photographic art.

VII. Applicant's arguments filed on 11/24/08 have been fully considered but they are not persuasive.

The arguments filed on 11/24/08 has been carefully considered but has little values since the above rejection are applied with a new set of the references.

XI. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 7:30 AM to 4:30 PM on Monday though Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hoa V. Le/

Primary Examiner, Art Unit 1795

01/04/08